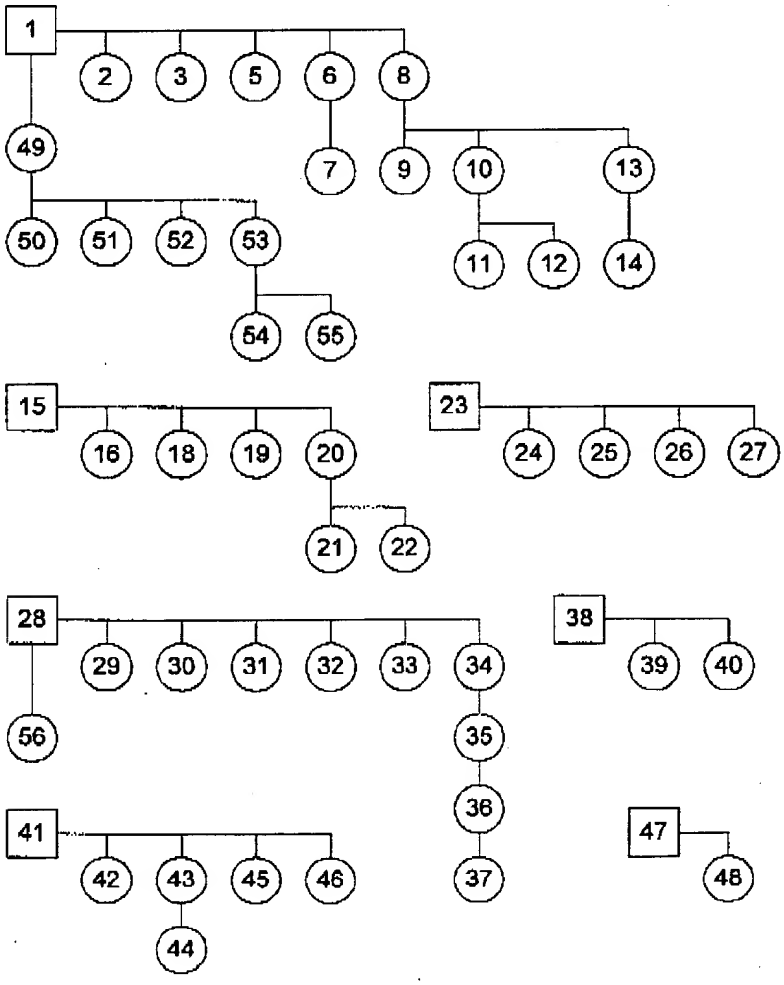
In re Application of VETRIVELKUMARAN et al.
Application No. 09/681,844

REMARKS

Reconsideration of the application is respectfully requested. An Office action mailed July 1, 2004 is pending in the application. Applicants have carefully considered the Office action and the references of record. In the Office action, claims 1-3, 5-16 and 18-48 were rejected under 35 U.S.C. § 103 and claim 1 was rejected under 35 U.S.C. § 112, first paragraph. In this response to the Office action, claims 1, 15, 23, 28, 38, 41 and 47 have been amended, and claims 49-56 have been added. Therefore, claims 1-3, 5-16 and 18-56 are pending in the application. The following diagram depicts the relationship between the independent and dependent claims.



Rejections Under 35 U.S.C. § 103 of the Independent Claims

Each of the independent claims 1, 15, 23, 28, 38, 41 and 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of Raz et al., U.S. Patent Application Publication No. 20020138640 (hereinafter *Raz*), U.S. Patent No. 5,859,971 to Bittinger et al. (hereinafter *Bittinger*), U.S. Patent No. 6,115,741 to Domenikos et al. (hereinafter *Domenikos*) and Eylon et al., U.S. Patent Application Publication No. 20010034736 (hereinafter *Eylon*). Each rejection includes *Domenikos* as part of the combination because none of *Raz*, *Bittinger* or *Eylon* describes "executing an application program outside of [a] client computing device." (Office action mailed July 1, page 7, lines 3-4). However, not only do the related publications *Raz* and *Eylon* not show an application program being executed outside of a client computing device, they implicitly and explicitly teach away from execution outside of the client computing device because, for example, they describe a system that merely pushes data blocks and services requests.

> As will be appreciated, because the server **does not execute** the streamed program, **but simply pushes data blocks and services requests**, the server's operating environment **does not need to be compatible** with the client environment.

(*Eylon*, paragraph 0073, emphasis added). Nevertheless, applicants have amended the independent claims to prevent any confusion with respect to the teachings of *Raz* and *Eylon*. In addition to executing an application program outside the client computing device, each of the independent claims 1, 15, 23, 28, 38, 41 and 47 has been amended herein to require that the application program executes on a compatible computing platform at the computing device where the execution occurs. For example, independent claim 1 as amended specifies a caching computing device where application program execution occurs as "having an execution platform compatible with the application program."

The Manual of Patent Examining Procedure (M.P.E.P.) states that the prior art must be considered as a whole, including those disclosures that teach away from the claimed invention.

> A prior art reference **must** be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

(M.P.E.P. § 2141.02, section titled "PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE

CLAIMS," emphasis added). The M.P.E.P. further states that if one or more references in a combination teach away from the combination then the combination is improper.

> It is **improper** to combine references where the references teach away from their combination.

(M.P.E.P. § 2145 (X)(D)(2), section titled "References Cannot Be Combined Where Reference Teaches Away from Their Combination," emphasis added). Therefore, combinations of *Raz* and/or *Eylon* ("does not execute") with *Domenikos* ("executes") are improper.

Each combination of references used to reject the independent claims 1, 15, 23, 28, 38, 41 and 47 includes *Raz* and/or *Eylon* with *Domenikos*. Therefore, each rejection under 35 U.S.C. § 103(a) of the independent claims 1, 15, 23, 28, 38, 41 and 47 is improper and should be withdrawn.

Rejections Under 35 U.S.C. § 112 of the Independent Claims

Independent claim 1 was further rejected in the Office action under 35 U.S.C. § 112, first paragraph, for lack of support in the specification with respect to an "original" computing device. Although applicants disagree, independent claim 1 has nevertheless been amended herein to instead reference a "client" computing device.

Newly Added Claims

Claims 49-56 have been added in this amendment to more particularly point out and distinctly claim the invention as described by the specification. In compliance with 37 C.F.R. § 1.121(f), they do not add new matter.

The Remaining Dependent Claims

Each of claims 1, 15, 23, 28, 38, 41 and 47 is in independent form, whereas all of the remaining claims depend directly or indirectly on one of these seven independent claims. The dependent claims are allowable for at least the same reasons that the seven independent claims 1, 15, 23, 28, 38, 41 and 47 are allowable in that the dependent claims incorporate the features of the independent claims. Nevertheless, the dependent claims further define subject matter not shown or rendered obvious by the prior art of record. Because the

independent claims are allowable over the applied prior art, applicants do not believe remarks addressing this further subject matter are necessary herein.

CONCLUSION

The application is considered in good and proper form for allowance, and the examiner is respectfully requested to pass this application to issue. If, in the opinion of the examiner, a telephone conference would expedite the prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,

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